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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,154	07/08/2003	Michael A. Epstein	PHA 23,636A	8245

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EXAMINER

LABAZE, EDWYN

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,154

Applicant(s)

EPSTEIN, MICHAEL A.

Examiner

EDWYN LABAZE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2202004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of amendments filed 2/20/2004.
2. Receipt is acknowledged of IDS filed 2/20/2004.
3. Claims 1-8 and 27-30 are presented for examination.
4. This application is a divisional of application No. 09/454,350 (now US patent 6,601,046) filed in 12/30/1999 and claims the benefits of application no. 60/126, 167 filed in 3/25/1999.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose (U.S. 5,708,709).

Re claims 1 and 27: Rose discloses system and method for managing try-and-out usage of application programs, which includes a memory portion 124 storing content material (col.3, lines 30+); a usage indicator [through the computer system 107] for recording a measure of usage associated with the content material in the memory portion (col.2, lines 15+; col.3, lines 10+) and a baseline register for storing at least one baseline-usage parameter for facilitating a determination of a validity period [herein disclosed as a try-and-buy program in which the user is given a valid license for a specified amount of days after which a time bomb is set to prevent operation/copy of the program] associated with the content material based on the usage indicator

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(col.10, lines 1-67; col.11, lines 1-45), further includes means of rendering the content material in dependence upon the validity period and the measure of usage (col.9, lines 50-67; col.10, lines 1+).

Re claim 28: Rose teaches system and method, further comprises the step of determining an authenticity [using client access privileges and predetermined access conditions to typically identify the client/user] of the baseline-usage parameter (col.7, lines 27+); and wherein the rendering the content material is in dependence upon the authenticity of the baseline-usage parameter (col.7, lines 49+).

Re claim 29: Rose discloses a system and method, further comprises the step of decrypting the content material to facilitate the rendering (col.8, lines 20+).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (U.S. 5,708,709) in view of Tajiri (U.S. 6,072,757).

Re claim 2: The teachings of Rose have been discussed above.

Rose fails to teach a counter being incremented by a playback device when playback device accesses the content material.

Tajiri discloses apparatus and method for determining a disk type prior to reproducing data from the disk, which includes a counter being incremented by one each time the playback device accesses the content material (col.7, lines 58+-67; col.8, lines 1-33).

In view of Tajiri's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Rose a counter being incremented by a playback device when playback device accesses the content material as to control/manage the number of times the user has accessed the content material. Furthermore, such modification could provide a security means [such as in the case of a try-and-buy program] to prevent the user to have access [such as record, view/download] to the content material after a certain number of trials or period of usage, provide means of accessing the content material after a predetermined number of trials and present to the user the possibility to buy the content material. Moreover, such modification would have been an obvious extension as taught by Rose.

Re claim 3: Rose discloses a system and method, wherein the at least one baseline-usage parameter includes a copy of measure of usage on the recording medium when the content material is stored in the memory portion (col.5, lines 13+).

Re claim 4: Rose teaches a system and method, wherein the at least baseline-usage parameter also includes a usage limit for facilitating the determination of the validation period (col.9, lines 50+).

Re claim 5: Rose discloses a system and method, wherein the at least baseline-usage parameter is stored in the baseline register in a secure form for facilitating a determination of an authenticity [using client access privileges and predetermined access conditions to typically identify the client/user] of the at least one baseline-usage parameter (col.7, lines 27+).

Re claim 6: Rose teaches a system and method, wherein the at least one baseline-usage parameter is associated with the content material in a secure form for facilitating a determination of an authorization of the content material (col.2, lines 7-14; col.5, lines 30-67; col.6, lines 1-7).

Re claim 8: Rose discloses a system and method, wherein the at least one baseline-usage parameter includes a security encoding based on a private key of a public-private key pair 137 associated with a providing source of the content material (col.3, lines 40+); the security encoding including at least one of a digital signature bound to the at least one baseline-usage parameter, and an encryption [through the encryption module 135] of the at least one baseline-usage parameter (col.5, lines 26-67).

Claims 7 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (U.S. 5,708,709) as modified by Tajiri (U.S. 6,072,757) above in claim 2, and further in view of Linnartz (U.S. 6,314,518).

The teachings of Rose as modified by Tajiri have been discussed above.

Rose as modified by Tajiri fails to teach that the content material contains a watermark, and the at least one baseline-usage parameter further includes a ticket based on hash value of the watermark.

Linnartz discloses system for transferring content information and supplemental information relating thereto, which includes a content material [such as DVD] that is watermarked (col.3, lines 25+; col.4, lines 20+); and a ticket 25/26 based on the hash value of the watermark (col.4, lines 54+; col. 9, lines 12-37).

In view of Linnartz's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Rose as

modified by Tajiri a watermark method and a ticket based on the hash values of the watermark to allow a copy-once mechanism. Furthermore, such modification would reinforce the security protocol of the copyright protection and prevent hackers to successfully break any improved systems. Moreover, such modification would have been an obvious extension as taught by Rose as modified by Tajiri.

Response to Arguments

9. Applicant's arguments with respect to claims 1-8 and 27-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Allan et al. (U.S. 6,526,456) discloses distribution and controlled use of software products.

Cannon et al. (U.S. 6,678,824) teaches application usage time limiter.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
May 10, 2004



THIEN M. LE
PRIMARY EXAMINER